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EXAMINER

GUILL, RUSSELL L

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT H. BRACEWELL

Appeal 2010-008449
Application 10/507,002¹
Technology Center 2100

Before JOHN A. JEFFERY, JAMES D. THOMAS, and
CAROLYN D. THOMAS, *Administrative Patent Judges*.

C. THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL²

¹ Application filed September 8, 2004. The real party in interest is BAE SYSTEMS PLC and Rolls-Royce PLC.

² The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 1, 2, 4-6, 8, 10, 15, 17-19, 22, 33, 41, 47, 48, and 50, which are all the claims remaining in the application, as claims 3, 7, 9, 11-14, 16, 20, 21, 23-32, 34-40, 42-46, 49, and 51-54 are cancelled. We have jurisdiction over the appeal under 35 U.S.C. § 6(b). Attendance at the Requested Oral Hearing was waived.

We AFFIRM.

The present invention relates to “increasing the efficiency of a design process. In particular, this invention relates to improvements in the efficiency of the capture of the rationale behind design decisions. Such captured design rationale may subsequently be reused in future design decisions which may be associated with the same or different design projects or problems.” (Spec., 1, ll. 4-9.)

Claim 1 is illustrative:

1. A design knowledge information capture tool comprising:

a storage means for storing design knowledge information generated or acquired during progress of a first design project, wherein the design knowledge information extends beyond product design information and includes information on evolution of a first design project and causal dependencies between items of said design knowledge, said storage means comprising a plurality of files, each file having a predefined knowledge structure for including a list of issues to be addressed;

an input means for allowing a user to input information into the storage means; and

a presentation means for presenting a file template of each of said plurality of files to the user to allow the information to be input by the user in said predefined knowledge structure, wherein said presentation means presents each said structure as an array of nodes, each node representing an item of said design knowledge, wherein a dependency between items of said design knowledge is represented by a directed link between selected nodes, wherein said directed link is bi-directional to permit a user to traverse the link in either direction, and wherein said selected nodes represent items of design knowledge stored in different files.

Appellant appeals the following rejection:

Claims 1, 2, 4-6, 8, 10, 15, 17-19, 22, 33, 41, 47, 48, and 50 under 35 U.S.C. § 103(a) as unpatentable over Conklin (Jeff Conklin et al., “gIBIS: A Hypertext Tool for Exploratory Policy Discussion, ACM Transactions on Office Information Systems, Vol. 6, No. 4, October 1988, Pages 303-331) in view of Hirose (USP 5,784,286, Jul. 21, 1998) and Regli (W.C. Regli et al., “A Survey of Design Rationale Systems: Approaches, Representation, Capture and Retrieval,” 2000, Engineering with Computers, Vol. 16, Pages 209-235).

FACTUAL FINDINGS

1. Conklin discloses nodes and their interconnecting links. (Conklin, *see* page 306, ll. 17-18, Fig. 2 and page 307, Fig. 3.)

2. Kogan discloses that “[a] hyperlink is bi-directional, meaning it can be traversed in either direction from either anchor.” (Kogan, col. 4, ll. 37-38.)

3. Weinreich discloses that “bi-directional links help to keep links consistent and to avoid broken links.” (Weinreich, page 22.)

ANALYSIS

Appellant argues claims 1, 2, 4-6, 8, 10, 15, 17-19, 22, 33, 41, 47, 48, and 50 as a group (App. Br. 8-21). For claims 2, 4-6, 8, 10, 15, 17-19, 22, 33, 41, 47, 48, and 50, Appellant repeats the same argument made for claim 1. We will, therefore, treat claims 2, 4-6, 8, 10, 15, 17-19, 22, 33, 41, 47, 48, and 50 as standing or falling with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(vii). *See also In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991).

Official Notice

Issue 1: Did the Examiner err in finding that it was well known at the time of the invention to have a directed link between selected nodes that is bi-directional?

The Examiner used Official Notice to show that the use of a “bi-directional directed link” was well known at the time of the invention, rather than the previously cited Conklin, Hirose, and Regli references. (Ans. 15.) Specifically, the Examiner presented documentary support of the Official Notice by citing three additional references: (1) Kogan (USP 5,809,317, Sep. 15, 1998), (2) Nguyen (USP 5,481,666, Jan. 2, 1996), and (3) Weinreich (Harald Weinreich et al., “The Look of the Link-Concepts for the User Interface of Extended Hyperlinks,” 2001, Proceedings of the 12th ACM conference on Hypertext and Hypermedia, Pages 19-28). (App. Br. 3-4.)

Appellant contends that while the documentary evidence Kogan “discloses bi-directional links that have multiple endpoints, it is unclear as to how such a system could be incorporated into the framework of a ‘design

knowledge information capture tool’ as required in independent claim 1 or the method of claim 33.” (App. Br. 9.) Appellant further contends that the other documentary evidence, Weinreich, “discloses bi-directional linking, but specifically teaches away from its use in graphical maps.” (*Id. at* 10.)

We start by noting that Appellant clearly admits that at least both Kogan and Weinreich disclose “bi-directional links” (App. Br. 9-10)(FF 2-3). In other words, Appellant concedes that it was well known to use “bi-directional links.” However, Appellant contends that it is unclear how Kogan’s bi-directional links could be incorporated into the framework of a design tool as claimed (App. Br. 9). Here, the Examiner is merely demonstrating that “bi-directional links” are well known. We agree. Conklin, Hirose, and Regli are being used to show the claimed design tool. (Ans. 15.) Specifically, Conklin is being used to illustrate links between nodes (FF 1) in a hypertext tool for exploratory policy discussion (Conklin, *see title*). The Examiner imports the above-noted Official Notice documentary evidence to merely show that it was well known that such links can be bi-directional.

MPEP § 2144.03(c) provides the requirements to traverse Official Notice: “[S]pecifically point out the supposed errors in the [E]xaminer’s action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art.” *See* 37 C.F.R. 1.111(b) (2005). *See also In re Chevenard*, 139 F.2d 711, 713 (CCPA 1943). Here, Appellant has failed to adequately traverse the Examiner’s Official Notice stating that it was old and well known to use bi-directional links between nodes. In fact, Appellant agrees that it was well known. Appellant’s

argument that such Official Notice does not show the “design tool” aspects of the invention is also unpersuasive given that it is undisputed by Appellant that the combination of Conklin, Hirose, and Regli discloses such design tool features. Therefore, we find that including “bi-directional links” between nodes is admitted prior art.

Regarding Appellant’s argument that Weinreich teaches away from using bi-directional links in graphical maps, we agree with the Examiner that Weinreich merely teaches limitations to this approach, but fails to criticize, discredit or otherwise discourage the use of bi-directional links (Ans. 23).

“What the prior art teaches and whether it teaches toward or away from the claimed invention ... is a determination of fact.” *Para-Ordnance Mfg., Inc. v. SGS Imps. Int’l, Inc.*, 73 F.3d 1085, 1088 (Fed. Cir. 1995) (citations omitted). “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). Teaching an alternative or equivalent method, however, does not teach away from the use of a claimed method. *In re Dunn*, 349 F.2d 433, 438 (CCPA 1965). For example, Weinreich merely discloses methods to overcome the limitations associated with using bi-directional links, e.g., limiting the number of objects used (Weinreich, page 22, top right column). Thus, we find that Weinreich does not teach away from using bi-directional links between nodes.

Again, we note that Appellant does not dispute any of the Examiner’s specific findings pertaining to Conklin, Hirose, and/or Regli. As such, only those arguments actually made by Appellant has been considered in this

decision. Arguments which Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Hindsight Argument

Issue 2: Did the Examiner improperly use hindsight bias to combine the cited references?

Appellant contends that “the Examiner has simply utilized hindsight reasoning in picking and choosing elements from Conklin, Hirose, Regli and the purported Official Notice references.” (App. Br. 12.)

The Examiner responds that “a motivation to combine the teachings of the references is provided, and thus a proper *prima facie* case of obviousness is provided. Further, the Examiner may also take into account the inferences and creative steps that a person of ordinary skill in the art would employ.” (Ans. 17.) We agree with the Examiner.

“A factfinder should be aware . . . of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1742 (2007) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 36 (1966)). In other words, “[i]t is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (quoting *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991)). Consequently, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (citing *In re Lee*, 277 F.3d 1338,

1343-46 (Fed. Cir. 2002); *In re Rouffet*, 149 F.3d 1350, 1355-59 (Fed. Cir. 1998)).

Here, the Examiner provided an articulated reason with some rational underpinning for combining the cited references on at least pages 7-8 of the Answer, i.e., cost effective, useful and inexpensive, a great aid to designers, a basis for designers to explore more design options. Thus, we find the Examiner's numerous reasonings to be sufficient.

Based on the record before us, we are not persuaded that the Examiner erred in rejecting (1) representative claim 1; (2) independent claim 33 which recites commensurate argued limitations; and (3) claims 2, 4-6, 8, 10, 15, 17-19, 22, 41, 47, 48, and 50 not separately argued.

Accordingly, we affirm the rejection of claims 1, 2, 4-6, 8, 10, 15, 17-19, 22, 33, 41, 47, 48, and 50.

DECISION

We affirm the Examiner's § 103(a) rejection.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2010).

AFFIRMED

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